

REMARKS

The Examiner "renumbered" claims 1-3, 5-8 and 11-22 as claims 1-19. Applicant has amended the claims to reflect this renumbering including the dependency references. Claims 1-19 are currently pending in this application.

The Rejections under 35 U.S.C. §102(e)

The Examiner rejected claims 1-19 under 35 U.S.C. 102(e) as being anticipated by Hasegawa [6,510,438] and under 35 U.S.C. 102(e) as being anticipated by Gifford [6,549,612].

The Cited Art Distinguished

Hasegawa was filed December 17, 1998 as a continuation-in-part (CIP) of application USSN 09/179,519 filed October 27, 1998 which claims the priority of Japanese Patent Application 9-315931 filed October 31, 1997. Therefore the potential 102(e) dates for Hasegawa, depending up on the subject matter of the claims, are October 27, 1998 and December 17, 1998. The present application was filed September 21, 1999. Applicant reserves the right to swear behind Hasegawa at a future date.

Hasegawa describes an electronic mail system including a communication line, at least one transmitting terminal, at least one receiving terminal, and at least one communication terminal connected to each other through the communication line. The communication terminal is said to receive, through the communication line, an electronic mail sent by the transmitting terminal and then transfers the received electronic mail to the receiving terminal corresponding to an address of the electronic mail. The transmitting terminal attaches song data comprising musical tone control information, to the electronic mail, and transmits the electronic mail with the song data attached, to the communication terminal. The communication terminal then stores the received electronic mail in a storage device, notifies the receiving terminal of receipt of the electronic mail, retrieves the electronic mail and the song data attached to the mail from the storage device, and transfers them to the receiving terminal upon the request

of the notified receiving terminal. The receiving terminal opens the received electronic mail, and automatically reproduces the song data attached to the electronic mail.

The Examiner appears to be saying that Applicant's limitation of initializing at least one application program by automatically retrieving code from a server over a network after an electronic message received over the network is opened for viewing by a user as set forth in claim 1 is disclosed by Hasegawa at column 2, lines 20-35 and column 11, line 60, which are reproduced below:

Column 2

20 According to the first aspect as defined above, the receiving terminal receives the electronic mail sent by the transmitting terminal, along with song data comprising musical tone control information attached to the mail, the song data
25 attached to the electronic mail is automatically reproduced when the electronic mail is opened. Therefore, since the song data comprising musical tone control information is attached to the electronic mail and sent to the receiving terminal, high-quality musical tone or voice represented by
30 a small quantity of data can be transmitted and received along with the electronic mail. Further, upon opening of the electronic mail, the user need not open the attached file containing song data, and start an appropriate application for reproducing the song data in the opened file, thus assuring
35 improved efficiency with which the user operates the receiving terminal.

Column 11

nal is connected. The connection server receives the request for mail delivery from the transmitting terminal at a step S22, and sends samples of electronic mail data stored in a 60 storage device (for example, hard disc in the HDD 11) of the connection server, to the transmitting terminal. The samples of electronic mail data may be in the form of image data

Contrary to the assertions of the Examiner, Hasegawa does not disclose, teach or suggest application programs as recited by Applicant but, rather, his invention is directed to the attachment of song data (which can include musical tones and short voice passages) to e-mails. Second, even if song data could, *arguendo*, be considered "code", Hasegawa does not retrieve the song data from a server after the e-mail is opened. The song data is already there as an attachment and it is automatically played after the e-mail is opened. Hasegawa therefore does not meet the claim limitation of

initializing at least one application program by automatically retrieving code from a server over a network after an electronic message received over the network is opened for viewing by a user.

The Examiner also seems to be saying that the limitations of automatically executing the application program of the electronic message within the context of the electronic message is met by Hasegawa at column 10, lines 53-65, reproduced below:

Column 10

The receiving terminal receives the electronic mail data at a step S8, and displays the character data and image data
55 included in the electronic mail data, together with a playback button, on the display device 9 at a step S9. At the same time, the receiving terminal automatically reproduces MIDI data contained in the electronic mail data, and transmits the data to the tone generator circuit 15 at a step S10. At a step S11,
60 the tone generator circuit 15 produces a musical tone signal based on the reproduced data, and transmits the signal to the effect circuit 16, which in turn adds various effects to the musical tone signal thus produced. The sound system 17 receives the resulting musical tone signal from the effect
65 circuit 16, and generates corresponding sound.

First, as noted above, Hasegawa does not disclose, teach or suggest application programs as recited by Applicant but, rather, song data which accompanies an e-mail as an attachment. Applicant's claimed application programs are not attachments but, rather, programs executed within the context of an electronic message. Applicants, in fact, disclose that the prior art includes attachments including sound attachments (such as Hasegawa's), as noted below:

Using e-mail, a person can send messages and other information as attachments electronically to other e-mail users. Such attachments normally include pictures, sound recordings, formatted documents, etc. that are in digital form, and which are executable independent of opening and reading of the message included with the e-mail. (Applicant's Background of the Invention, page 1, line 27 to page 2, line 2, emphasis added)

Therefore, e-mail attachments such as Hasegawa are admitted prior art and are different from the application programs claimed by Applicant.

Because not all of the elements of the claims are found in Hasegawa, the rejection under 35 U.S.C. § 102(e) is in error and should be withdrawn.

Gifford (U.S. Patent No. 6,549,612) describes a method and system for providing unified messages services to a subscriber. The subscriber utilizes an active interface embedded in an e-mail notification to control delivery of a non-literal, single media or multimedia message to the subscriber. Such a non-literal message includes, but is not limited to, any of a hyperlink-based message, a voicemail message, a facsimile, and a video clip. The active interface provides access to communications-related services as well, including access to stock/options trading and bill payment.

Gifford was filed May 6, 1999, claims the priority of a provisional application USSN 60/084,457 filed May 6, 1998, and was issued on April 15, 2003. The present application was filed September 21, 1999. Applicant reserves the right to swear behind Gifford at a future date.

A primary example used by Gifford concerns an e-mail notification system for an individual. Should virtually any type of electronic message be received by the individual, an e-mail notification is sent to the individual informing him of that fact. Optionally, the individual can access the electronic message remotely through the instrumentality of the e-mail notification.

An e-mail notification is shown by Gifford in Fig. 2, reproduced below. As can be clearly seen, the notification does not include the message itself but, rather, an alert that a message has been received. In this case, a message in the form of "3 seconds of urgent voice mail" for Tom Doe had been received from Sandra Jones. There are also some "Alerts and Notification" which indicate notification status based upon certain criteria.

3 SECONDS OF URGENT VOICE MAIL

MESSAGE RECEIVED AT 9:18 am EST 5/5/98

FROM: SANDRA JONES (732/675920) TO: TOM DOE

201 LISTEN/VIEW SAVE DELETE FORWARD OPTIONS HELP

CALLING SERVICES

202 PHONE # TO CALL: YOUR PHONE #:

RETURN THIS CALL PLACE A CALL CALL ME BACK NOW LISTEN BY PHONE

SETUP A PHONE CONFERENCE

ALERT AND NOTIFICATIONS

203 A LOCATION OVERRIDE OF 732-673-3942 IS IN PLACE UNTIL 10:00am EST
JOHN SMITH HAS LEFT YOU 5 MESSAGES SINCE 8:30am EST
COMPANY XYZ STOCK IS NOW TRADING AT \$17/SHARE CLICK TO TRADE

SETUP AND CONFIGURATION

204 OVERRIDES PROFILE LOGIN LOGOUT

QUICK OVERRIDES

205

	DURATION	PHONE NUMBER LOCATION
MAKE ME UNAVAILABLE NOW		
SET NEW PHONE LOCATION		
TURN ON CALL SCREENING		

CURRENT TIME: 9:20am EST 5/5/98 MINI MESSAGE MANAGER

FIG. 2

It should be noted that Gifford does not provide the message itself, only the notification of the receipt of the message, in its e-mail notification. The “Mini Message Manager” depicted in Fig. 2 does, however, have a number of “controls” which permits the message to be listened to or viewed. However, the viewing or listening is not within the context of the notification e-mail but, rather, is through associated instrumentalities, e.g. the e-mail client or a web browser window. See, for example, the description in Gifford after the notification e-mail has been opened:

Once the recipient receives the e-mail message and opens it, the recipient sees the graphical HTML, WML or XML attachment either directly in an e-mail client or in a Web Browser depending upon the system configuration. Gifford, Col. 6, lines 62-66.

It is therefore clear that after the notification e-mail is opened (e.g. see Fig. 2), that another window, either provided by the e-mail client or by a web browser is used to display the message content. There is simply no reserved area or window in the notification e-mail for the display, for example, of the text of an e-mail message.

In short, Gifford teaches the use of an e-mail to provide a consolidated interface to access various types of messages and data including e-mail, voice mail, faxes and video. Each of these messages and data types would be displayed in their own environments, e.g. e-mail in an e-mail client environment, faxes in a fax display environment (e.g. a web page), video in a video environment (e.g. a media player). Therefore, Gifford does not teach **automatically executing the application program of the electronic message within the context of the electronic message after the initialization thereof**, and the rejection of the claims under 35 U.S.C. U.S.C. § 102(e) is in error and should be withdrawn.

Applicant believes that prior claims 1-19 are not anticipated by nor are they obvious over Hasegawa and/or Gifford. However, solely for the purpose of expediting the prosecution of this application, Applicant has amended the claims to include the limitation of wherein the application program becomes associated with a context of the electronic message after being sent but before being received by the user. This additional element even further distinguishes the claimed embodiments from the prior art of record. Applicant reserves the right to reintroduce the prior claims and claims of similar scope at a later date.

Applicant believes that all pending claims are patentable, and respectfully requests an early Notice of Allowance. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Date: May 14, 2008

Respectfully submitted,



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